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APR 26 2004

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## Fax transmittal

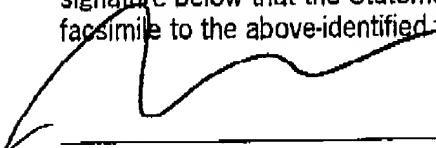
To	Examiner F. Lu	Date	April 26, 2004
Company	United States Patent and Trademark	From	Kevin E. Noonan
	Office, Group Art Unit 1634	Direct	312-913-2145
Fax	1-703-305-3014	Email	Noonan@mbhb.com
Phone		C/M	
Pages, with cover	6		
Re			

Patent Application Serial No. 09/966,515

Attorney Docket No. 00-1312-C

**MESSAGE:** Please deliver to Examiner Lu as soon as possible.

**Certificate of Facsimile Transmission:** The undersigned attorney hereby certifies by his signature below that the Statement Pursuant to 37 C.F.R. Sec. 1.97(3)(2) was sent by facsimile to the above-identified facsimile number on Monday the 26<sup>th</sup> day of April 2004.



Kevin E. Noonan  
35,303

300 South Wacker Drive      312 913 0001 phone  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**(Case No. 00-1312-C)**

**PATENT**

In application of: )  
Kopreski ) Before the Examiner:  
Serial No. 09/966,515 ) F. Lu  
Filed: September 28, 2001 )  
For: Method Enabling the Use of Extracellular )  
(RNA Extracted from Plasma or Serum to )  
Detect, Monitor or Evaluate Cancer )

**TRANSMITTAL LETTER**

Commissioner of Patents  
P.O. Box 1450  
Arlington , VA 20231

Sir:

In regard to the above-identified application:

1. We are transmitting herewith the attached
  - a. Statement pursuant to 37 C.F.R. Sec. 1.97(3)(2)
2. With respect to additional fees:
  - a. No additional fee is required.
3. Please charge any deficiency or credit any overpayment to Deposit Account No. 13-2490.
4. CERTIFICATE UNDER 37 C.F.R. 1.10: The undersigned hereby certifies that this Transmittal Letter and this paper, as described in paragraph 1 herein above, are being sent by facsimile transmission to telephone number 703-746-5100 as set forth non the accompanying Facsimile Transmittal Sheet, addressed to: Examiner F. Lu, c/o Commissioner for Patents, Washington, D.C. 20231 on this 22<sup>nd</sup> day of April 2004

By:

\_\_\_\_\_  
Kevin E. Noonan, Ph.D.  
Reg No. 35,303

McDonnell Boehnen Hulbert & Berghoff  
300 S. Wacker Drive  
Chicago, IL 60606  
(312) 913-0001

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
(Case No. 00-1312-C)

**PATENT**

<b>In application of:</b>	)	
	)	
Kopreski	)	<b>Before the Examiner:</b>
	)	F. Lu
<b>Serial No.</b>	<b>09/966,515</b>	)
	)	<b>Group Art Unit: 1634</b>
<b>Filed:</b>	<b>September 28, 2001</b>	)
	)	
<b>For:</b>	<b>Method Enabling the Use of Extracellular RNA Extracted from Plasma or Serum to Detect, Monitor or Evaluate Cancer</b>	)
	)	

**STATEMENT PURSUANT TO 37 C.F.R. §1.97(e)(2)**

Commissioner of Patents  
P.O. Box 1450  
Arlington , VA 20231

Dear Sir:

Pursuant to the provisions of 37 C.F.R. §1.97(e)(2), Applicants hereby state:

"That no item of information was contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any person designated in Sec. 1.56(c) more than three months prior to the date that this paper and the accompanying Information Disclosure Statement were originally submitted on July 22, 2003."

The U.S. Patent and Trademark Office, having once charged Deposit Account 13-2490 for the full amount of the fee required under 37 C.F.R. §1.17(p), Applicants respectfully contend no additional fee is due and owing. However, by the signature of the undersigned the Office is once again authorized to charge the Deposit Account. Applicant is entitled to Small Entity Status.

McDonnell Boehnen Hulbert & Berghoff  
300 S. Wacker Drive  
Chicago, IL 60606  
(312) 913-0001

Should the Examiner believe a discussion of this matter would be helpful, he is invited to telephone the undersigned at (312) 913-0001.

Respectfully submitted,  
**McDonnell Boehnen Hulbert & Berghoff**

By:

Kevin E. Noonan  
Reg. No. 35,303

Date: April 22, 2004

**McDonnell Boehnen Hulbert & Berghoff**  
300 S. Wacker Drive  
Chicago, IL 60606  
(312) 913-0001

Substitute for form 1449A/PTO				<b>Complete if Known</b>	
				<b>Application No.</b>	09/986,515
				<b>Filing Date:</b>	9/28/02
				<b>First Named Inventor</b>	Kopreski
				<b>Group Art Unit</b>	1655
				<b>Examiner Name</b>	
(use as many sheets as necessary)				<b>Attorney Docket No.</b>	00-1312-C
Sheet	1	of	1		

**U.S. PATENT DOCUMENTS**

#### **OTHER DOCUMENTS – NON PATENT LITERATURE DOCUMENTS**

Examiner Initials*	Cite No. 1	Include name of author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T <sup>2</sup>
		FLEISCHHACKER <i>et al.</i> , "Detection of Amplifiable Messenger RNA in the Serum of Patients with Lung Cancer," <i>Annals New York Academy of Sciences</i> , 197:179-88 (October 2001).	

**\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 809. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.**

<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3).

**4** For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. **4** Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST-18 if possible. **Applicant is to place a check mark here if English translation is attached.**

**Burden Hour Statement:** This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington DC 20231. DO NOT SEND FEES



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Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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8

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

According to 37 C.F.R. 197 (e), "each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the statement.". Since applicant does not show that "no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application," that states in 37 C.F.R. 197 (e), applicant's statement pursuant to 37 C.F.R. 1.97 (e) filed on July 22, 2003 does not satisfy 37 C.F.R. 197 (e) and IDS filed on July 22, 2003 will not be considered.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571)272-0782.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu  
PSA  
March 2, 2004

*[Signature]*  
**BJ FORMAN, PH.D.**  
**PRIMARY EXAMINER**